DETAILED ACTION

1. This non-final Office action is in reply to the Decision on the Petition regarding Applicants request to withdraw requirement for restriction filed on 18 March 2010 and the amendment filed 26 October 2009.

2. Claims 1-10 have been amended.

3. Claim 12 is new and has been added.

4. The restriction/election requirement for Claim 11 has been withdrawn due to the decision on the petition to withdraw requirement for restriction and Claim 11 has been re-instated in the claims.

5. Claims 1-12 are currently pending and have been examined.

Petition for Review by the Office of Petitions

6. The Petition for Review by the Office of Petitions filed 26 October 2006 for constructively withdrawn Claim 11 has been granted in the Decision on the Petition regarding Applicants request to withdraw requirement for restriction filed on 18 March 2010. Claim 11 has been re-instated, is currently pending, and has been examined.

Response to Amendment
Response to Arguments

7. Applicant's arguments filed 26 October 2009 have been fully considered but they are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9.   Claims 1-6, 11, and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 11, and 12 are directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should <u>positively recite</u> the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Typical statutory support comprises computer architecture components recited within the body of the claims such as, for example, a computer with a processor including a database for processing results for limitations stated within the body of the claims. Claims 2-4 and 5 depend from independent Claim 1 and 4, respectively, and have the same deficiencies and missing elements and are rejected for the same rationale.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: it is not clear _how_ the _scoring, creating, retrieving, and transmitting_ are specifically able to be performed in Claims 7-9 Under the broadest reasonable interpretation, the _means/function for_ scoring, creating, retrieving, and transmitting could be software _per se_ (emphasis added). Because software _per se_ is not tangible and statutory, it does not constitute as sufficient structure. Clarification is required.

11. The claim limitations "_means for/function for_" scoring, creating, retrieving, and transmitting" uses the phrase "means for", but are modified by some structure, material, or acts recited in the claims. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because these limitations could be software _per se_.

If applicant wishes to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claims so that the phrase "means for" and "function for" are clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claims so that they will clearly not be a means (or function) plus function limitation (e.g., deleting the phrases "means/function for"). Proper clarification is required.

12. Additionally and included in the rejection under 35 U.S.C. 112, second paragraph, Claim 9 recites, "_A computer readable storage...distributing program...for executing on a computer..._" in the preamble of the claim. For proper clarification and examination purposes, the Examiner will interpret the preamble of Claim 9 as reciting, "_A computer-readable program product tangibly embodied on a computer-readable storage medium, that, when executed, causes one or more computer processors to..._" (to perform the limitations recited in the body of the claim). Correction and clarification is required.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another
filed in the United States before the invention by the applicant for patent or (2) a patent granted on an
application for patent by another filed in the United States before the invention by the applicant for patent,
except that an international application filed under the treaty defined in section 351(a) shall have the effects
for purposes of this subsection of an application filed in the United States only if the international application
designated the United States and was published under Article 21(2) of such treaty in the English language.

14.   Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Erickson (U.S. 6,098,067).

With regard to Claims 1, 7, 9, and 11, Erickson teaches *an operations management method*

distributing method, apparatus, and program (remote computer management system) *for a computer*

network (network of computers) *system having a plurality of computers* (number of remote computers) (see

at least the Abstract and column 1, lines 48-60), *comprising:*

- *upon receiving inventory information specifying an inventory* (files, script) *based upon one of*

  hardware and software (manages files or runs applications, platform) *of a computer* (remote

  computers) *to be managed, retrieving from a database operations management methods of*

  the computer to be managed (task, actions) *corresponding to the specified inventory* (actions,

  variables) *and creating a method list detailing operations management policies* ("Create

  Directory" action) *suited to the inventories specified by said inventory information* (user,

  working from a single server, builds and executes a script which manages files or runs

  applications at any number of remote computers) (see at least column 1, line 48 through

  column 2, line 44 and column 3, line 30 through column 4, line 9);

- *sending back the created method list to a manager* (package of commonly performed

  operations) (see at least column 3, line 30 through column 4, line 53);

- *upon receiving selection information indicating the selection by the manager of at least one operations management method of the computer to be managed from said created method list, retrieving from said database and acquiring the operations management method specified by said selection information* (contains the path for the directory to be created by operation of this action) (*see at least* column 4, lines 3-53);

- *sending back the retrieved operations management method of the computer to be managed to the computer to be managed* (is the directory to which the files are copied to from the server) (*see at least* column 4, lines 3-53).

With regard to Claim 2, Erickson teaches:

- *appropriately storing said inventory information in a database* (*see at least* column 3, lines 3-59);

- *extracting a difference between said inventory information and the inventory information stored in said database when said inventory information is received, wherein said step of creating a policy list, retrieves from said database and creates a policy list suited to the inventory specified by said difference* (actions assigned to the node) (*see at least* column 4, lines 3-53).

With regard to Claims 5, 8, and 10, Erickson teaches *an operations management method distributing method, apparatus, and program* (remote computer management system) *for a computer network* (network of computers) *system having a plurality of computers* (number of remote computers) (*see at least* the Abstract and column 1, lines 48-60)*, comprising:*

- *upon receiving inventory information specifying an inventory* (Each node in the hierarchy inherits the actions and variables of its hierarchical parent(s)) *based upon one of hardware and software* (files, applications, platform) *of a computer* (computers) *to be managed, retrieving from a database operations management methods of the computer to be managed* (file management system, files, actions, variables, nodes, storing the variable values at the server) *corresponding to the specified inventory* (particular set of software) *and acquiring operations management methods of the computer to be managed suited to the inventory specified by said inventory information* (files, actions, variables, nodes) (*see at least* column 1, line 48 through column 2, line 44);

- *sending back the acquired operations management methods of the computer to be managed* (to which a script of actions is to be applied) (*see* at least column 1, line 48 through column 2, line 44).

With regard to Claim 6, Erickson teaches *setting for each operations management method of the computer to be managed whether or not the deletion is allowable* (DELETE)*, wherein said step of acquiring said operations management methods of the computer to be managed necessarily acquires those operations management methods set as non-deletable methods regardless of their usage frequency* (see at least column 1, lines 59-67).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 3, 4, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson as recited for Claims 1, 2, and 5-12 above and in view of Donovan et al (Donovan) (U.S. 6,012,032).

With regard to Claim 3, Erickson does not specifically teach *appropriately storing in a database usage frequencies of the operations management methods of the computer to be managed applied to said computer to be managed; appending the usage frequencies stored in said database to each of the operations management methods of the computer to be managed detailed in said method list.* Donovan teaches *appropriately storing in a database* (data elements **42** are selected and reformatted into records for usage by data storage utilization accounting system **10**) *usage frequencies* (usage of each type of hardware media is monitored and recorded, data storage utilization statistics) *of the operations management methods of the computer to be managed* (for each storage device) *applied to said computer to be managed* (usage cost); *appending the usage frequencies stored in said database to each of the operations management methods of the computer to be managed detailed in said method list* (summarize usage) in analogous art of accounting for data storage for the purposes of, "provides an output of billing elements" (see at least column 1, lines 24-39, column 3, lines 1-46, column 5, lines 1-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method for accounting computer data storage utilization as taught by Donovan with the remote computer management method of Erickson. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately billing a user for computing and data processing usage or internal charge-back (Donovan, column 1, lines 17-22).

With regard to Claim 4, Erickson does not specifically teach *the number of references, the operating time and the number of applications of each of the operations management methods of the computer to be managed applied to said computer to be managed.* Donovan teaches *the number of references* (Accounting code), *the operating time* (Date and Time) *and the number of applications* (Data Set Name, Quantity) *of each of the operations management methods of the computer to be managed applied to said computer to be managed* in analogous art of accounting for data storage for the purposes of, "provides an output of billing elements" (see at least column 1, lines 24-39, column 3, lines 1-46, column 5, lines 1-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method for accounting computer data storage utilization as taught by Donovan with the remote computer management method of Erickson. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately billing a user for computing and data processing usage or internal charge-back (Donovan, column 1, lines 17-22).

With regard to Claim 12, Erickson teaches a method comprising:

- analyzing software and hardware currently in a computer to be managed (to define the network hierarchy and assign actions and variables to nodes within the hierarchy, the system's ability to gather information from remote computers and use that information to set values for variables used in action scripts) (see at least column 3, line 43 through column 5, line 65);

- providing a list of computer management policies (action script, files, hierarchical arrangement) based on the software and hardware in the computer, the list sorted in descending order (hierarchy) based on usage frequency (inheritance feature) of each policy in the list (see at least column 3, line 43 through column 5, line 65);

- storing the list of computer management policies (file management system, files, actions, variables, nodes, storing the variable values at the server) (see at least column 1, line 48 through column 2, line 44);

- accepting selection of one of plurality of policies from a system manager and applying the selection to manage the computer (to define the network hierarchy and assign actions and variables to nodes within the hierarchy, the system's ability to gather information from remote computers and use that information to set values for variables used in action scripts) (see at least column 3, line 43 through column 5, line 65);

Erickson does not specifically teach *the number of references, the operating time and the number of applications of each of the operations management methods of the computer to be managed applied to said computer to be managed.* Donovan teaches *the number of references* (Accounting code), *the operating time* (Date and Time) *and the number of applications* (Data Set Name, Quantity) *of each of the operations management methods of the computer to be managed applied to said computer to be managed* in analogous art of accounting for data storage for the purposes of, "provides an output of billing elements" (*see* at least column 1, lines 24-39, column 3, lines 1-46, column 5, lines 1-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method for accounting computer data storage utilization as taught by Donovan with the remote computer management method of Erickson. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately billing a user for computing and data processing usage or internal charge-back (Donovan, column 1, lines 17-22).

Erickson and Donovan do not expressly teach the specific data recited in Claims 4 and 12; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.*

Conclusion

17.   The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Fukunaga et al (U.S. 6,144,993) discloses a building automation system including usage monitoring for computer management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boswell Beth can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3624

16 April 2010
Thomas Mansfield

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623